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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/514,422	06/29/2005	Joo-Ho Kim	1793.1553	8814

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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

MULVANEY, ELIZABETH EVANS

ART UNIT	PAPER NUMBER
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1794

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06/13/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/514,422	Applicant(s) KIM ET AL.	
	Examiner Elizabeth E. Mulvaney	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/16/04, 5/19/06, 10/24/06</u> . | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 6, 7, 12, 13, 18, 19, 24-26, 29 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,709,978.

The reference discloses a recording medium comprising a substrate, a first protective dielectric layer, a recording layer, a second dielectric layer, and a reflective layer where the recording layer comprises a high-melting point component. Recording is performed with a laser where there is diffusion between the recording layer and a protective dielectric layer. See col. 18, lines 35-38.

Claims 1-6, 13-18, and 25-30 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,999,392.

The reference discloses a recording medium comprising a recording layer having dielectric layers on either side thereof. The recording layer comprises a high melting point component such as Ta or W. See col. 16. Recording is performed with a laser. It is recognized that the reference does not specify that the crystals operate as a scattering source or generate surface plasmon. However, as the same materials are disclosed, these are seen to be inherent properties.

Claims 1-34 are rejected under 35 U.S.C. 102(e) as being anticipated by US 2005/0254408.

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The reference discloses a medium comprising a high melting point layer between dielectric layers where recording is performed with a laser by diffusing the recording material and a dielectric material. The CNR and recording power are disclosed. See claims 21, 25, and Figure 2 and 8.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Claims 1, 2, 5, 6, 19, 20, 22, 25, 26, 28, and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by US 7,087,284.

The reference discloses a medium comprising a tungsten oxide layer having dielectric layers on either side. The medium may also comprise a reflective layer. Recording is performed by a laser resulting in a surface plasmon effect. See claim 7 and col. 4.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Claims 1, 2, 5, 6, 25, 26, 28 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by US 7,166,346.

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The reference discloses a medium comprising a tungsten oxide layer having dielectric layers on either side. The medium may also comprise a reflective layer. See claims 7 and 11.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Claims 1, 2, 5, 6, 25, 26, 28 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by US 2004/0247891.

The reference discloses a medium comprising a tungsten oxide layer having dielectric layers on either side. The medium may also comprise a reflective layer. See claims 30 and 52.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*,

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140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 5, 6, 19, 20, 22, 25, 26, 28, and 30 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 7 of U.S. Patent No. 7,087,284. Although the conflicting claims are not identical, they are not patentably distinct from each other because they disclose a medium comprising a tungsten oxide layer having dielectric layers on either side. The medium may also comprise a reflective layer. Recording is performed by a laser resulting in a surface plasmon effect. It is recognized that the patent does not claim the recording method or apparatus. However, when looking to the specification to further define the claims, these are found.

Claims 1, 2, 5, 6, 25, 26, 28 and 29 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 7 and 11 of U.S. Patent No. 7,166,346. Although the conflicting claims are not identical, they are not patentably distinct from each other because they disclose a medium comprising a tungsten oxide layer having dielectric layers on either side. The medium may also comprise a reflective layer.

Claims 1-34 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 21 and 25 of copending Application No. 11/119,919. Although the conflicting claims are not identical, they are not patentably distinct from each other because they disclose a medium comprising a high melting point layer between dielectric layers where recording is performed with a laser by diffusing the recording material and a dielectric

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material. The CNR and recording power are disclosed. The method and apparatus are not claimed.

however, when looking to the specification to further define the claims, they are found.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1, 2, 5, 6, 19, 20, 22, 25, 26, 28, and 30 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4, 26 and 45 of copending Application No. 10/509,367. Although the conflicting claims are not identical, they are not patentably distinct from each other because they disclose a medium comprising a tungsten oxide layer having dielectric layers on either side. The medium may also comprise a reflective layer.

Recording is performed by a laser.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1, 2, 5, 6, 25, 26, 28 and 29 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 30 and 52 of copending Application No. 10/849,522. Although the conflicting claims are not identical, they are not patentably distinct from each other because they disclose a medium comprising a tungsten oxide layer having dielectric layers on either side. The medium may also comprise a reflective layer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth E. Mulvaney whose telephone number is 571-272-1527. The examiner can normally be reached on Monday-Friday 9am-5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elizabeth E. Mulvaney/

Primary Examiner, Art Unit 1794